

Remarks

In the Office Action mailed November 21, 2005, claims 1 through 5 were rejected under 35 USC 103(a) as being unpatentable over U.S. Patent 5,028,990 to Kotaki et al (hereinafter the '990 patent) in view of U.S. Patent 5,576,240 to Radosevich et al. (hereinafter the '240 patent). The following remarks apply to the Office Action and the present amendments.

Rejection under 35 USC 103

"To establish a *prima facie* case of obviousness, three basic criteria must be met." MPEP 2143. One of the requirements is that all of the claim limitations must be taught or suggested. MPEP 2143.03. The amended independent claims now recite that the insulating material (shown, for example, as 16 in original FIG. 2) be formed from a single layer of material. Furthermore, the amended independent claims now recite that the substrate (shown, for example, as 10 in original FIG. 2) be of a single layer with a doped semiconductor structure. Moreover, the amended independent claims recite that the patterning stop region (shown, for example, as 14' with layers 15A and 15B in original FIG. 2) be in contact with that single layer substrate. Thus, in addition to the other recited features, any purported combination of references must also include these features.

The combined teaching of the '990 and '240 patents do not teach such features. Specifically, rather than disclosing the claimed single layer attributes, the '990 and '240 patents depict more complicated multilayer configurations. Such configurations with a multiplicity of components are not interchangeable with the simpler claimed structure. This is consistent with long-standing U.S. patent practice, where courts give effect to a claim recitation that makes it clear that a recited article is limited to the singular. *Insituform Technologies, Inc. v. CAT Contracting, Inc.*, 40 USPQ2d 1602, 1608 (Fed. Cir. 1996). In the present situation, the '990 patent unequivocally teaches multiple insulating layers 6 and 8, neither of which individually satisfies the claimed requirement that a *single* layer be in contact with the substrate *and* have a container region formed within. FIGS. 4b, 9 and 10 of the '990 patent, some of which were

relied on by the Examiner, show an insulating layer 6 intermittently formed along the upper surface of substrate 1, while a separate insulating layer 8 includes a container region 9 disposed therein. The discrete nature of the two layers is clear, as the first insulating overlayer 6 is neither made from the same material as that of insulating overlayer 8 nor contiguous with it. Similarly, the '240 patent includes a substrate with dual layers 11 and 18, as well as a single layer of insulating material 13, all as shown in FIGS. 1 and 6. Column 2, lines 60 through 62 of the '240 patent indicates that substrate layer 18 is a doped polysilicon layer, while substrate layer 11 is a field oxide (i.e., electrically insulative) layer. As shown in the figures, the patterning stop region 12 cannot be in contact with the doped substrate 18, and as such cannot satisfy the claim recitation.

Since the each of the recited features are not taught in the cited references, the requirement of MPEP 2143.03 is not satisfied, and reliance upon the cited references is no longer available. Accordingly, the Applicant requests that the present rejection be withdrawn. As such, the Applicant respectfully submits that all of the claims are patentable over the cited art, and are entitled to a finding of allowability by the Examiner. The Examiner is encouraged to contact the undersigned to resolve efficiently any formal matters or to discuss any aspects of the application or of this response.

Respectfully submitted,
DINSMORE & SHOHL L.L.P.

By


John D. Reed
Registration No. 46,506

One Dayton Centre
One South Main Street, Suite 1300
Dayton, Ohio 45402-2023
Telephone: (937) 449-6453
Facsimile: (937) 449-6405